

Request for Reconsideration:

Applicant acknowledges with appreciation that the Examiner indicates that claims 8-12 would be allowable if rewritten in independent format, including the limitations of their base claim and any intervening claims. In accordance with the Examiner's suggestions, Applicant has canceled original claims 1, 7, and 8, without prejudice to the subject matter claimed thereby, and has added new independent claim 13, which substantially incorporates the limitations of original claims 1, 7, and 8. Applicant also has amended claims 2, 4, 5, 9, 10, and 12 to depend from new independent claim 13. Moreover, Applicant has added new independent claim 14, which substantially incorporates the limitations of original claims 1 and 5, and new claims 15 and 16, which depend directly or indirectly from new independent claim 14. No new matter is added by the foregoing amendments, and these amendments are fully supported by the specification. Applicant respectfully requests that the Examiner reconsider the above-captioned patent application in view of the foregoing amendments and the following remarks.

Remarks:

1. Rejections

The title of the invention stands objected to as allegedly being non-descriptive of the claimed invention. Claims 1-4 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,421,243 to Burkett et al. ("Burkett"). Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Burkett, as applied to claim 1, in view of U.S. Patent No. 5,013,219 to Hicks et al. ("Hicks"). Moreover, claim 7 stands rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Burkett, as applied to claim 1, in view of U.S. Patent No. 4,790,727 to Steele.

2. Title of the Invention Objections

The title of the invention stands objected to as allegedly being non-descriptive of the claimed invention. Applicant has amended the title of the invention in accordance with the Examiner's suggestions. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to the title of the invention.

3. 35 U.S.C. § 102(b)

Claims 1-4 stand rejected as allegedly anticipated by Burkett. "A claim is anticipated if and only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131. The Office Action alleges that Burkett describes each and every element as set forth in claims 1-4. Applicants respectfully traverse.

Applicant has canceled original, independent claim 1, without prejudice to the subject matter claimed thereby. Therefore, the anticipation rejection of independent claim 1 is rendered moot.

Applicant has amended claims 2 and 4 to depend from new independent claim 13, and claim 3 depends from claim 2. New independent claim 13 substantially incorporates the limitations of original claim 8, it's base claim 1, and intervening claim 7, which the Examiner indicates would be allowable. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claims 2-4.

4. 35 U.S.C. § 103(a)

Claims 5 and 6 stand as allegedly rendered obvious by Burkett, as applied to claim 1, Hicks, and claim 7 stands rejected as allegedly rendered obvious by Burkett, as applied to claim 1, in view of Steele. Applicant respectfully traverses this rejection, as follows.

Applicant has canceled original claim 7, without prejudice to the subject matter claimed thereby. Therefore, the obviousness rejection of claim is rendered moot.

Applicant has amended claim 5 to depend from new independent claim 13, and claim 6 depends from claim 5. As described above, new independent claim 13 substantially incorporates the limitations of original claim 8, it's base claim 1, and intervening claim 7, which the Examiner indicates would be allowable. "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03 (citations omitted). Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claims 5 and 6.

5. New Claims 14-16

Applicant has amended the above-captioned patent application to include new claims 14-16. New independent claim 14 substantially incorporates the limitations of original claims 1 and 5, and new claims 15 and 16 depend directly or indirectly from new independent claim 14. Therefore, Applicant has addressed new independent claim 14 in view of the obviousness rejection of original claim 5 based on Burkett and Hicks.

In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. At least for the reasons set forth below, Applicant maintains that the Office Action fails to establish a prima facie case of obviousness with respect to new claims 14-16.

Applicant's new independent claim 14 describes a swash plate compressor, comprising "metallic intermediate sleeves arranged between the outer shell and the center sleeve and individually defining the cylinder bores therein to form **gaps** within the outer shell outside of the intermediate and center sleeves; and a **resin filler filling the gaps.**"

In contrast to Applicant's claimed invention as set forth in independent claim 14, Burkett describes a compressor comprising a solid cylinder block 12, a center bore formed at the center of cylinder block 12, and a plurality of cylinder bores 26 formed in the cylinder block, which are arranged at regular intervals in the circumferential direction of the cylinder bore. Nevertheless, the center bore and cylinder bores 26 do not form gaps in cylinder block 12.

Therefore, cylinder block 12, the center bore, and cylinder bores 26 cannot correspond to the outer shell, the center sleeve, and the intermediate sleeves of Applicant's claimed invention as set forth in independent claim 14. Moreover, Hicks does not disclose or suggest those elements of Applicant's claimed invention as set forth in independent claim 14 that are missing from Burkett. Therefore, Applicant respectfully requests that the Examiner allow independent claim 14 to issue in a U.S. patent.

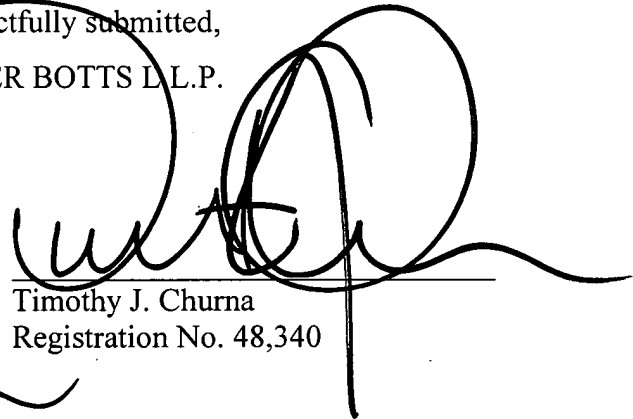
Claims 15 and 16 depend from allowable, independent claim 14. Therefore, Applicant respectfully requests that the Examiner also allow new claims 15 and 16 to issue in a U.S. patent.

Conclusion:

Applicant respectfully submits that this application, as amended, is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity. Applicant is enclosing a check in the amount of \$120.00 covering the requisite large entity fee for a one-month extension of time to respond. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the U.S. Patent and Trademark Office, please charge or credit such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,
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Dated: April 26, 2006

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Enclosure